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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,109	11/21/2001	Randall A. Boudouris	M112.2-10064	2833

490 7590 10/03/2003

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER	
PIAZZA CORCORAN, GLADYS JOSEFINA	
ART UNIT	**PAPER NUMBER**
1733	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/990,109	BOUDOURIS ET AL.	
	Examiner	Art Unit	
	Gladys J Piazza Corcoran	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-71* is/are pending in the application.

4a) Of the above claim(s) *42 and 44-59* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41,43 and 60-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5, 7, 8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-41, 43, 60-70, drawn to a process of forming a magnetic assembly, classified in class 156, subclass 297.

   II. Claims 42, 44-59, drawn to an article capable of adhering to a magnetic metal surface, classified in class 428, subclass 332.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed may be made by another and materially different process such as applying a coating of magnetic material without elevating the temperature, with a solvent mixture that dries, etc.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Lisa Ryan-Lindquist and Examiner Vivek Koppikar on May 27, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-41, 43, 60-70. Affirmation of this election must be made by applicant in replying to this Office action. Claims 42, 44-59 are withdrawn from

further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

6. The disclosure is objected to because of the following informalities: The amendment filed August 9, 2002 inserts the heading "Cross Reference to Related Applications", which is already in the Specification. The Amendment also adds a reference to priority of Application Serial Number 09/990,109; which is the present Application. It is noted, the Specification already recites a reference to priority to a provisional Application Serial No. 60/253,191.

Appropriate correction is required.

Claim Objections

7. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 70 and 71 have been renumbered 69 and 70.Claim 43 is objected to because of the following informalities: Claim 43 recites in line 1, "substage" which should be --substrate--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 62 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 62 recites that the molten magnetic composition comprises magnetic material in an amount effective to render the composition self-adhering to a substrate comprising a ferromagnetic material. The Specification only discloses making a magnetic assembly that would self-adhere to a magnetically attracted surface.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 2, 3, 6, 62, 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 2 recites the limitation "said applying step b)" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --said applying step c)--.

14. Claim 3 recites the limitation "said applying step b)" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --said applying step c)--.

15. Claim 6 is unclear by reciting said magnetic composition **has** cooled to ambient temperature. It is suggested to amend to -- said magnetic composition **is** cooled to ambient temperature--.

16. Claim 62 is unclear by reciting the molten magnetic composition comprises magnetic material in an amount effective to render the composition self-adhering to a substrate comprising a ferromagnetic material. The scope of the claim is unclear as to when or what amount of magnetic material is required to render the composition self-adhering to a substrate comprising ferromagnetic material. It is also unclear how strong the adhering must be to meet the claim.

17. Claim 63 recites the limitation "said applying step b)" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --said applying step c)--.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claims 1-4, 6-9, 14-16, 18, 22-26, 29-31, 38-40, 43, 60-65, 68, 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverchotz et al. (US Patent No. 5,869,148).

Silverchotz discloses a method of forming a magnetic assembly by providing a molten magnetic composition comprising at least one magnetic material and at least one thermoplastic binder (column 2, lines 19-27), forming the magnetic composition (601) into the magnetic layer at an elevated temperature (using a hot melt polymer; column 3, line 22), and directly applying the magnetic layer at an elevated temperature when it is pliable to a printable substrate layer (web 200) (the hot melt composition is coated onto the substrate layer).

As to claim 1, Silverchotz discloses the composition comprising 70% magnetic material and 30% binder (column 3, lines 25-30). As to claims 2, 63, the magnetic layer is applied in thickness and width dimensions in the final form. As to claim 3, the magnetic layer is also affixed in the length dimension in final form. As to claim 4, the assembly is subjected to a strong magnetic field sufficient to result in a permanent magnetic effect in the assembly (column 5, lines 50-68). As to claim 6, the assembly is cooled to room temperature. As to claim 7, the magnetizing step occurs after the applying step. As to claim 8, the printable substrate is printed (column 2, lines 53-62). As to claims 9 and 69, the assembly is formed on a roll form on a web. As to claim 14, Silverchotz discloses the claimed coating types (column 3, lines 59-61). As to claims 15 and 60, Silverchotz discloses extruding (column 3, lines 61-62). As to claims 16 and 64,

the magnetic composition is a ferrite. As to claims 18 and 65, the compositions of the thermoplastic binder are disclosed (column 3, lines 50-58). As to claims 22-24, 68, the thickness of the magnetic layer is disclosed (column 7, lines 10-15). As to claim 25, the magnetic composition is applied in the form of at least one ribbon. As to claim 26, the ribbon is pressed onto the substrate (in figure 5 with the rollers and in figure 4 when the sheet is folded over). As to claim 29, the ribbon is discontinuous with the printable substrate, see figure 4 for example. As to claim 30, the printable layer are the materials as claimed (column 2, lines 60-65). As to claim 31, Silverchotz discloses treating the printable layer (column 3, lines 1-8). As to claim 38, Silverchotz discloses the claimed articles (column 7, line 49 to column 8, line 5). As to claim 39, the magnetic layer is continuous with the printable layer (see figure 7). As to claim 40, the magnetic layer is discontinuous with the printable layer (see figure 4). As to claim 43, adequate adhesion is obtained between the magnetic layer and the printable substrate layer. As to claim 62, the magnetic material is at an amount sufficient to render the composition magnetically self-adhering.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

21. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

22. Claims 1-4, 6-9, 14-26, 29-31, 38-40, 43, 60-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverchotz et al. (US Patent No. 5,869,148) as applied to claims 1, 61 above, and further in view of Sawa (US Patent No. 4,022,701).

As to claims 1-4, 6-9, 14-16, 18, 22-26, 29-31, 38-40, 43, 60-65, 68, 69, these are rejected as discussed above. The reference Silverchotz discloses the thermoplastic binder amount can be at 30%. However it is known in the art to provide thermoplastic amounts in magnetic compositions as little as 4% (column 4, lines 5-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic material in Silverchotz with known percentages of thermoplastic as is exemplified by Sawa, only the expected results would be attained. As to claims 16-17, 64, Sawa discloses this conventional formula for magnetic material. As to claims 18-20, 65-67, the selection of such well known and available thermoplastic materials for a binder in a magnetic layer is considered conventional and obvious to one of ordinary skill in the art, furthermore, Sawa discloses such compositions. As to claim 21, this is a

conventional particle size for magnetic material in addition Sawa discloses such (column 2, line 43).

23. Claims 10-13, 16, 18-20, 22-24, 27, 64-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverchotz et al. (US Patent No. 5,869,148) and optionally Sawa (US Patent No. 4,022,701) as applied to claims 1, 61 above.

As to claims 10 and 69, Silverchotz discloses forming the sheet in a roll, however it is considered well known in the art to alternatively form individual sheets, only the expected results would be attained. As to claims 11, 12, 70, it is considered well known in the art to stack manufactured cards and apply shrink wrap around the stacks for distribution. As to claim 13, it is well within the purview of one of ordinary skill in the art to select the appropriate temperature of application which is only dependent upon the thermoplastic binder selected, the thickness of the materials and the other selected materials. As to claims 16 and 64, the claimed formula is considered to be a conventional formula for magnetic materials. As to claims 18 and 65, it would have been well within the purview of one of ordinary skill in the art to select any of the claimed binders as these are considered conventional. As to claims 19, 20, 66 and 67, although Silverchotz does not specifically disclose using a polyalphaolefin, such thermoplastic binders are considered well known and one of ordinary skill in the art would readily recognize using such compositions, only the expected results would be attained. It is noted that applicant admits in the Specification on page 7 that it is common for the terms polyolefin and polyalphaolefin to be used interchangeably. As to claims 22-24, 68, it would have been well within the purview of one of ordinary skill in

the art to select the appropriate thickness as claimed, such a thickness is considered within the conventional range and is only dependent upon the final product desired. As to claim 27, it is considered conventional to press extruded layers to substrates with a chill roll.

24. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverchotz et al. (US Patent No. 5,869,148) and optionally Sawa (US Patent No. 4,022,701) as applied to claim 1 above, and further in view of Rippingale et al. (US Patent No. 5,114,517).

Silverchotz discloses subjecting the extruded layer to a magnetic field, but does not disclose if this is done while the extruded layer is still at an elevated temperature. Rippingale discloses subjecting an extruded magnetic layer to a magnetic field in order to provide a magnetic effect in the assembly (column 3, lines 10-28). The magnetic assembly is subjected to a magnetic field while the magnetic composition is at an elevated temperature (column 3, line 20). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by Silverchotz and optionally Sawa by subjecting the assembly to a magnetic field while the extruded layer is at an elevated temperature in order to provide a magnetic effect in the assembly while the magnetic particles can still be aligned as shown by Rippingale.

25. Claims 28, 39, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverchotz et al. (US Patent No. 5,869,148) and optionally Sawa (US Patent No.

4,022,701) as applied to claim 1 above, and further in view of Martin (US Patent No. 5,458,282).

It is unclear if Silverchotz discloses the magnetic layer is of the same width as the printable layer. However, Silverchotz discloses that the method can be used to produce a variety of products (column 7, line 49 to column 8, line 11). Furthermore, it is known to provide these products with a magnetized layer that has the same width as the printable layer. For example, Martin discloses such a product. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of applying a magnetic layer to a printable substrate as shown by Silverchotz and optionally Sawa by providing the magnetic layer with the same width as the printable substrate as is known in the art to form particular products similar to those disclosed by Silverchotz and as exemplified by Martin, only the expected results would be attained.

26. Claims 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverchotz et al. (US Patent No. 5,869,148) and optionally Sawa (US Patent No. 4,022,701) as applied to claim 1 above, and further in view of Schramer et al. (US Patent No. 5,019,436).

Schramer discloses an example of a well known advertising concept of temporarily adhering coupons/marketing articles to a release layer that is adhesively attached to a product article, such as packages, containers, etc. to allow removal of the marketing article from the product article. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic

assembly as shown by Silverchotz and optionally Sawa by joining the assembly to a release liner that is adhered to an article in order to provide a removable magnetic assembly to products as shown by Schramer. As to claim 36, it is well known to provide an over-laminate to printed substrates, for example see Silverchotz (column 3, lines 1-8).

27. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverchotz et al. (US Patent No. 5,869,148) and optionally Sawa (US Patent No. 4,022,701) and Schramer et al. (US Patent No. 5,019,436) as applied to claim 32 above, and further in view of Martin '624 (5,924,624), Fosbenner et al. (5,949,050), and/or Mack (US Patent No. 4,621,837).

It is well known in the art to perforate an overlaminate in the same dimensions as an underlying member in order to allow the overlaminate to provide protection to the underlying member until a consumer tears the overlaminate at the perforations in order to use the underlying member. Such perforations and assemblies are exemplified by Martin '624, Fosbenner, and/or Mack. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming an assembly as shown by Silverchotz, Sawa, and Schramer by providing perforations in an overlaminate in order to allow access by a user to the underlying assembly as is well known in the art and exemplified by Martin '624, Fosbenner, and/or Mack.

28. Claims 61-64, 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US Patent No. 5,983,537) and/or Martin (US Patent No. 5,458,282) in view of Breen et al. (US Patent No. 5,879,784).

Johnson discloses a method of forming a magnetic assembly with a magnetic layer (magnet 24) and a printable substrate layer (substrate 20). Martin discloses a method of forming a magnetic assembly with a magnetic layer (magnetic sheet material 24) and a printable substrate layer (section 20).

Both Johnson and Martin disclose adhesively securing the magnetic layers, however, it is well known in the art that an alternative to adhesively securing a magnetic layer to a substrate is to applying the magnetic composition at an elevated temperature or extrude the magnetic layer directly onto the substrate. For example, Johnson discloses there are other known methods in the art such as coating the magnetic material or otherwise applied thereto (column 1, lines 15-23). Breen discloses another example of applying the magnetic composition at an elevated temperature or extruding (providing a molten magnetic composition) a magnetic layer directly onto a substrate as an alternative to forming the magnetic strip and then applying as a tape (column 2, lines 50-60). The magnetic layer is thus formed and directly applied at an elevated temperature (the magnetic layer is extruded on the substrate). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the magnetic assembly as shown in either Johnson or Martin by extruding the magnetic layer onto the substrate as a well known alternative to adhesively securing as exemplified by Breen.

As to claim 62, the magnetic composition in Johnson and Martin contains enough magnetic material to render the composition magnetically attracted to a surface. As to claim 63, the magnetic layer is affixed to the printable substrate in dimensions of

thickness and width in final form. As to claim 64, the magnetic material formula claimed is considered a conventional formula for magnetic material. As to claim 68, these thickness ranges are considered well within the conventional range and it would have been obvious to one of ordinary skill in the art to select the appropriate thickness for the particular end product desired. As to claim 69, it is well known in the art to form cards such as the ones disclosed in Johnson and Martin continuously and formed into a roll or a sheet form, particularly when extruding one of the layers. As to claim 70, it is considered well known in the art to stack manufactured cards and apply shrink wrap around the stacks for distribution.

29. Claims 1-3, 8-41, 43, 60, 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. as applied to claim 61 above, and further in view of Sawa et al. (US Patent No. 4,022,701).

The references Johnson and/or Martin and Breen are applied as discussed above. As to the particular composition of the magnetic layer, such compositions are well known. For example, Sawa discloses extruding a magnetic layer with the claimed percentage range of magnetic material and the claimed percentage range of thermoplastic binder (column 2, lines 65-68). Such percentage ranges are considered known and well within the purview of one of ordinary skill in the art to select. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the magnetic strip on a substrate layer as disclosed by Johnson and/or Martin by applying the magnetic material through extrusion directly onto the substrate as a well known alternative to applying the magnetic material with an adhesive on the substrate

as exemplified by Breen and to further use a well known composition for the magnetic material used in extruding as shown by Sawa.

As to claims 2 and 3, the magnetic layers all have a thickness, width and length. As to claim 8, the printable substrate in Johnson and Martin is subject to printing. As to claim 9, it is well known in the art to form cards such as the ones disclosed in Johnson and Martin continuously and formed into a roll, particularly when extruding one of the layers. As to claim 10, it appears as though Johnson and Martin show forming the cards individual, furthermore this would have been an obvious choice of one of ordinary skill in the art. As to claims 11 and 12, it is considered well known in the art to stack manufactured cards and apply shrink wrap around the stacks for distribution. As to claim 13, it is well within the purview of one of ordinary skill in the art to select the appropriate temperature of application which is only dependent upon the thermoplastic binder selected, the thickness of the materials and the other selected materials. As to claims 14 and 15, Sawa discloses extrusion coating which is conventionally applied with a slot die. The other methods of coating are considered functionally equivalent alternatives and would have been well within the purview of one of ordinary skill in the art. As to claims 16-17, 64, Sawa discloses this conventional formula for magnetic material. As to claims 18-20, 65-67, the selection of such well known and available thermoplastic materials for a binder in a magnetic layer is considered conventional and obvious to one of ordinary skill in the art, furthermore, Sawa discloses such compositions. As to claim 21, this is a conventional particle size for magnetic material in addition Sawa discloses such (column 2, line 43). As to claims 22-24, these

thickness ranges are considered well within the conventional range and it would have been obvious to one of ordinary skill in the art to select the appropriate thickness for the particular end product desired. As to claim 25, the magnetic layer is applied in a ribbon. As to claim 26, it is considered conventional to press two layer when applying one to the other and joining. As to claim 27, it is considered conventional to press extruded layers to substrates with a chill roll. As to claims 28 and 41, the magnetic layer has the same length and width as the substrate in Martin and Breen. As to claims 29 and 40, the magnetic layer is discontinuous with the printed substrate in Johnson and in an embodiment in Martin, figure 14, and therefore it would have been obvious to apply the layer discontinuously. As to claim 30, these materials are considered conventional for printable substrates and disclosed by the references. As to claim 31, it is well known to provide a protective layer over printable substrates such as varnishes, lacquers or films, for example for example Martin discloses an overlay 440. As to claims 32, 33, and 35, Johnson discloses a release liner (32) adhered to an article (22) with adhesive (30) and the magnetic assembly is removed form the release liner. As to claim 36, it is well known to provide an over-laminate to printed substrates, for example Martin discloses an overlay 440. As to claim 37, it is considered well known in the advertising art to create an over-laminate that is larger than the label/coupon/magnetic strip and to provide perforations to access the item underneath the laminate. As to claim 38, Johnson and Martin disclose such assemblies. As to claim 39, the magnetic layer is continuous with the substrate in Martin and Breen. As to claim 43, adequate adhesion is obtained between the layers.

30. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. and Sawa as applied to claim 1 above, and further in view of Rippingale et al. (US Patent No. 5,114,517).

Rippingale discloses subjecting an extruded magnetic layer to a magnetic field in order to provide a magnetic effect in the assembly (column 3, lines 10-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by the references above by subjecting the assembly to a magnetic field in order to provide a magnetic effect in the assembly.

As to claim 5, the magnetic assembly is subjected to a magnetic field while the magnetic composition is at an elevated temperature (column 3, line 20). As to claim 6, the magnetic composition cools to ambient temperature in all the references. As to claim 7, the magnetizing step occurs after the magnetic layer is applied to a substrate.

31. Claims 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. and Sawa as applied to claim 1 above, and further in view of Schramer et al. (US Patent No. 5,019,436).

Schramer discloses an example of a well known advertising concept of temporarily adhering coupons/marketing articles to a release layer that is adhesively attached to a product article, such as packages, containers, etc. to allow removal of the marketing article from the product article. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by the references above by joining the assembly to a release liner

that is adhered to an article in order to provide a removable magnetic assembly to products as shown by Schramer. As to claim 36, it is well known to provide an over-laminate to printed substrates, for example Martin discloses an overlay 440.

32. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. and Sawa and Schramer et al. as applied to claim 32 above, and further in view of Martin '624 (5,924,624), Fosbenner et al. (5,949,050), and/or Mack (US Patent No. 4,621,837).

It is well known in the art to perforate an overlaminate in the same dimensions as an underlying member in order to allow the overlaminate to provide protection to the underlying member until a consumer tears the overlaminate at the perforations in order to use the underlying member. Such perforations and assemblies are exemplified by Martin '624, Fosbenner, and/or Mack. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming an assembly as shown by Johnson, Martin, Breen, Sawa, and Schramer by providing perforations in an overlaminate in order to allow access by a user to the underlying assembly as is well known in the art and exemplified by Martin '624, Fosbenner, and/or Mack.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (703) 305-1271. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gladys J Piazza Corcoran
Examiner
Art Unit 1733

GJPC